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UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 OAKLAND DIVISION

FINJAN LLC,
 Plaintiff,
 v.
 PALO ALTO NETWORKS, INC.,
 Defendant.

Case No. 4:14-CV-04908-PJH

**DEFENDANT PALO ALTO
 NETWORKS, INC.'S
 ADMINISTRATIVE MOTION FOR
 LEAVE TO INCLUDE
 ADDITIONAL CLAIM TERMS IN
 THE JOINT CLAIM
 CONSTRUCTION STATEMENT**

Ctrm: 3, 3rd Floor
 Judge: Honorable Phyllis J. Hamilton

1 Pursuant to Civil Local Rule 7-11 and Paragraph 4 of the Court’s Standing Order for
2 Patent Cases (“Standing Order”), Defendant Palo Alto Networks, Inc. (“PAN”) moves for leave
3 to include additional disputed claim terms in the Parties’ Joint Claim Construction Statement
4 (“JCCS”) due on July 16, 2021. To be clear, PAN is not requesting that the Court construe more
5 than ten terms at this time. Rather, PAN is requesting that the Court grant leave for the parties to
6 include in the JCCS the terms in dispute at the time the JCCS is filed, even if there are more than
7 ten. On the other hand, if the Court prefers to resolve all disputed terms together at the upcoming
8 *Markman* hearing, PAN is prepared to do that as well.

9 Each of the asserted patents in this case has been the subject of extensive prior claim
10 construction—either in district court proceedings or before the Patent Trial and Appeals Board
11 (“PTAB”). Across those prior proceedings, there have been over 35 claim construction decisions,
12 which construed dozens of terms. (*See* Dkt. No. 118.) These prior constructions represent
13 significant investments by courts, the PTAB, and previous litigants in clarifying the scope and
14 meaning of the asserted claims. PAN believes this wealth of prior analysis should be used to
15 narrow the disputes in this case and clarify the claims’ meanings for the jury. As such, of the 21
16 terms currently disputed, 12 of PAN’s proposed constructions arise from prior claim construction.
17 For ten of these terms, Finjan responded that the terms should be given “plain and ordinary
18 meaning” and stated that “no construction [was] necessary.” Even after meeting and conferring,
19 it remains unclear whether Finjan believes the “plain and ordinary meaning” of these terms is
20 different from, or consistent with, the prior constructions and positions Finjan took in prior cases.

21 PAN is optimistic that the parties will reach agreement on (at least some) of the terms that
22 were previously litigated prior to the due date for the JCCS—two weeks from today. (*See* Decl.
23 of Diek O. Van Nort, filed herewith (“Van Nort Decl.”) Exs. 1-2.) Indeed, in meeting and
24 conferring prior to this motion, the parties were able to agree to constructions for two claim
25 terms. (*See* Van Nort Decl. Ex. 1.) The parties are scheduled to continue their meet and confer on
26 July 7, 2021, well in advance of the July 16, 2021 deadline for submitting the JCCS. (*Id.*)

27 As it stands today, however, there are greater than ten terms in dispute. The Court’s
28 Standing Order requires parties seek leave no less than two weeks in advance of the filing of the

JCCS if they wish to include greater than ten terms for construction in the JCCS. Specifically, as of this filing, there are 21 terms in dispute. (*Id.*) In the JCCS the parties will identify the top ten terms for construction at that hearing.

Good cause exists to include additional terms in the JCCS. The parties appear to have a dispute as to the appropriate construction of claim terms, and at this point it is not certain whether those disputes will be relevant to the trier of fact. “When the parties raise an actual dispute regarding the proper scope of [the] claims, the court, not the jury must resolve that dispute.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008). Inclusion will not burden the Court with additional work at this time, but will serve to crystallize the parties’ positions on claim construction in the event a dispute arises over one of these terms in the future. Moreover, for each of the terms in excess of the ten term limit, PAN relies on either previously settled constructions, portions of settled constructions, or previous positions taken by Finjan in other proceedings. Including these terms in the JCCS, thus, will eliminate gamesmanship while promoting judicial economy and consistency of interpretation across the Finjan patent families. Also, although not possible by the Court’s deadline for this filing, PAN is hopeful that the parties will be able to reach agreement on additional claim terms prior to the deadline for the JCCS.

Accordingly, PAN respectfully requests that the Court grant leave to the parties to include greater than ten disputed terms in the JCCS.

Dated: July 2, 2021

MORRISON & FOERSTER LLP

By: /s/ Colette Reiner Mayer
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